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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/635,598
Filing Date: August 06, 2003
Appellant(s): KAMINSKY ET AL.

Kaminsky, David Louis
Ogle, David M.

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 08/08/2008 appealing from the Office action mailed 03/05/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Claim 1-24 were not rejected under the second paragraph of 35 U.S.C. 112.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Tomkow	US 2002/0144154	Oct 3, 2002
Tomkow et al	US 2006/0112165	May 25, 2006
Delaney et al	US 2006/0177021	Aug 10, 2006
Horvitz	US 2002/0087649	Jul 4, 2002

(9) Grounds of Rejection

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-4 are rejected under 35 U.S.C. 101 because "intelligent electronic mail (e-mail) gateway" can be interpreted as software module (please see Specification Page 11, Paragraph 0023. Therefore, Claims 1-4 failed to be limited to embodiments which fall within a statutory category.

Specification

Claims 15-24 are objected to because according to MPEP 608.01, antecedent basis for the

terms appearing in the claims, while an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims. Applicant will be required to make appropriate amendment to the description to provide clear support or antecedent basis for the terms appearing in the claims provided no new matter is introduced. Claims 15-24 which contains the terminology "The machine readable storage" are lacking clear support or antecedent basis in the description of the specification. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 5, 6, 9, 15, 16, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Tomkow et al hereinafter Tomkow (US 2006/0112165).

1. Referring to Claims 1, 4, 5, and 15, Tomkow disclosed storing received e-mail messages prior to forwarding said messages to inboxes of respective mail servers (before sending the message to the destination, the messages is in the server/Rpost, refer to 0177 and 0080); detecting an impairment to delivering said messages to said inboxes (refer to 0129); identifying senders for selected one of said messages (refer to 0095-0097); and forwarding a notification of said impairment to said identified senders (refer to 0097).
2. Referring to Claims 6 and 16, Tomkow disclosed wherein said storing step comprises the step of queuing received e-mail messages prior to forwarding said messages to inboxes of respective mail servers (refer to 0177 and 0080).
3. Referring to Claims 9 and 19, Tomkow disclosed wherein said detecting step comprises the steps of: attempting to transmit said messages (refer to 0129); and, concluding the existence of an impaired state when said attempt fails (refer to 0129).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 12, 13, 14, 22, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomkow (US 2006/0112165) in view of Horvitz et al hereinafter Horvitz (US 2002/0087649).

4. Referring to Claims 2, 12, 13, 14, 22, 23, and 24, Tomkow disclosed wherein for each of said identified senders, formatting a notification comprising both a statement of said impairment (refer to 0147-0163) and forwarding said detailed notification to said identified senders (refer to 0147).

Although Tomkow disclosed the invention substantially as claimed, Tomkow is silent regarding “disclosed an alternate e-mail address for use in retransmitting a corresponding one of said messages”

Horvitz, in an analogous art disclosed an alternate e-mail address (refer to 0277) for use in retransmitting a corresponding one of said messages (refer to 0277);

Hence, providing an alternate email address for the sender to retransmit the email messages, would be desired for users to utilize due to the fact it provides the fastest time and proper knowledge of how to retransmit the messages to the proper destination.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Tomkow by including the features disclosed by Horvitz that efficiently improve the overall functionality of the system.

Claims 7, 8, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomkow (US 2006/0112165) in view of Delaney et al hereinafter Delaney (US 2006/0177021).

5. Referring to Claims 7, 8, 17, and 18, Tomkow disclosed wherein said detecting step comprises the step of consulting a data store of state information that already have identified impairment (refer to 0033).

Although Tomkow disclosed the invention substantially as claimed, Tomkow is silence regarding "consulting a data store of state information for selected ones of said respective mail servers to call an already identified impairment."

Delaney, in an analogous art disclosed consulting a data store of state information for selected ones of said respective mail servers to call an already identified impairment (server identified the known restriction or refer to 0058).

Hence, providing consulting a data store of state information for selected ones of said respective mail servers to call an already identified impairment disclosed by Delaney, would be desired for users to utilize due to the fact it can save loading time and efficiently eliminate unwanted mail from the mail system.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Tomkow by including the features disclosed by Delaney that efficiently improve the overall functionality of the system.

Claims 3, 10, 11, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomkow (US 2006/0112165) in view of Tomkow hereinafter Tomkow54 (US 20020144154).

6. Referring to Claims 3, 10, 11, 20 and 21, although Tomkow disclosed the invention substantially as claimed, Tomkow is silence regarding: wherein said step of identifying comprising the step of identifying only priority senders.

Tomkow54 in an analogous art disclosed, wherein said step of identifying comprising the step of identifying only priority senders (refer to Claim 7).

Hence, providing step of identifying only priority sender disclosed by Tomkow54, would be desired for users to utilize due to the fact it eliminate non priority senders and saving processing time.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Tomkow by including the features disclosed by Tomkow54 that efficiently improve the overall functionality of the system.

(10) Response to Argument

The examiner summarizes the various points raised by the appellant and addresses replies individually.

Specification Objections:

Appellant argued that:

(1) The claims provides adequate support in the specification for the term “machine readable storage”

Examiner respectfully disagrees.

In reply to argument:

(1) According to MPEP 608.01(o) that

“The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import; and in mechanical cases, it should be identified in the descriptive portion of the specification by reference to the drawing, designating the part or parts therein to which the term applies. A term used in the claims may be given a special meaning in the description. No term may be given a meaning repugnant to the usual meaning of the term.”

In another words, although the claim terminology was found in originally-presented claims 15-24, however, it “should be” apparent from the descriptive portion of the specification. For more information, please refer to MPEP 608.01(o) and 37 CFR 1.75(d)(1).

Therefore, appellant’s argument is in *clear error*.

Rejection of Claims 1-4 Under 35 U.S.C 101

Appellant argued that:

(1) The 101 rejection made to limitations is an incorrect statement of the law.

Examiner respectfully disagrees.

In reply to argument:

(1) Appellant allegedly stated that Claims 1-4 are statutory. However, as stated in the office action, appellant’s specification (see page 11, par 0023) has evidently stating that the invention (e.g., an intelligent electronic mail (e-mail) gateway) can be realized in “software”. Further, an intelligent e-mail gateway comprising: a message store configured to (a software

module) and a notification manager (a software module), thus, a intelligent e-mail gateway comprising only software modules are considered to be a software per se, which does not fall in any statutory category.

It is clear that appellant's argument is in *clear error*.

Rejection of Claims 1, 4-6, 9, 15-16, and 19 Under 35 U.S.C 102 for Anticipation based upon Tomkow

Claim 1

Appellant argued that:

- (1) There is not teaching of "...a mail server coupled to the e-mail gateway and associated with corresponding recipients.
- (2) There is no teaching of "a mail stores and a notification manager"
- (3) Tomkow fails to teach "notifying selected ones of said senders when delivery to said intended recipients has become impaired.

Examiner respectfully disagrees.

In reply to argument:

(1) Tomkow teaches the mail server (element 16, refer to Fig 3) coupled to the e-mail gateway (element 14, refer to Fig 3). Further, appellant alleged indicating that the claim limitation to be "the mail server is associated with the corresponding intended recipient" while the claim limitation stated otherwise as follow:

“a message store configured to store received messages forward by senders over a network to a mail server coupled to the e-mail gateway and associated with corresponding intended recipients;”

It is “a message store” that is associated with corresponding intended recipients, rather than as alleged by appellant, “the mail server”.

To further clarify how Tomkow teaches the limitation, Tomkow teaches that the system is not limited to only single recipient and sender but could be utilized by plurality recipients (“recipients to receive messages”, and par 0150) and plurality of senders (“senders sent messages” see par 0290).

Tomkow further teaches that the message store configured to store the messages forward by senders over a network (server RPost server 14 is capable to store messages forwarded by recipients, refer to 0080, and 0191) and the message store is associated with the corresponding intended recipients (see par 0150).

Therefore, it is clear that appellant’s argument is in *clear error*.

(2) Tomkow discloses “a message store”. As demonstrated in 0191 and 0080 of Tomkow, the RPost server 14 in Tomkow comprises functionality to store/make records of messages, therefore, Tomkow teaches “a message store”.

Further, Tomkow’s system teaches “a notification manager”. The notification manager is a functionality provided by Tomkow’s RPost server 14, where the RPost server 14 is mapped as appellant’s “intelligent e-mail gateway”. RPost server 14 is configured to notify sender when delivery to recipient has failed (see Tomkow par 0228 and 0229, specifically, par 0229, where “the notification information receipt that RPost will generate for the sender”.) Lastly, par 0251

and Fig 3 of Tomkow's teaches that a notification manager is coupled both to the message stores and the gateway (The RPost server 14 is collaborating with the MTA 16 in order to deliver messages to recipients.). Webster dictionary teaches the broadest reasonable interpretation for "coupling" is to join for combined effect. Therefore, a notification manager (merely software functionality) is "joined" with RPost server and with the memory store in RPost server.

Therefore, it is clear that appellant's argument is in *clear error*.

(3) As disclosed in (2), Tomkow teaches the functionalities of a notification manager: "notifying selected ones of said senders when delivery to said intended recipients has become impaired."

The specific teaching could be found in Tomkow, par 0229, where "the notification information receipt that RPost will generate for the sender". Furthermore, Tomkow disclosing RPost 14 comprising functionality to notify senders the status when the message is un-able to send to the recipient, see paragraph 0144, 0145, 0158, and specifically 0177.

Therefore, it is clear that appellant's argument is in *clear error*.

Rejection of Claims 2, 12-14 and 22-24 Under 35 U.S.C 103 for Obviousness based upon Tomkow in view of Horvitz

Claim 2

Appellant argued that:

(1) Although Horvitz teaches the concept of an alternate e-mail address, Horvitz fails to teach the limitations for which the Examiner is relying upon Horvitz to teach.

Examiner respectfully disagrees.

In reply to argument:

(1) As already admitted in its argument by Appellant that the Horvitz teaches the concept of an alternate e-mail address, Horvitz further discloses that the its system is capable to present users an additional contact information such as an additional e-mail address when the user cannot be reached see par 0277.

Therefore, it is clear that appellant's argument is in *clear error*.

Claim 12

Appellant argued that:

(1) Tomkow's mapping of "detailed notification describing the nature of the impairment." is not comparable to the claimed "nature of said impairment."

Examiner respectfully disagrees.

In reply to argument:

(1) According to the Appellant's claim limitation, the limitation does not further define what is "the nature of the impairment)." Tomkow teaches the alleged missing limitation. Tomkow discloses the notification send to sender disclosing the delivery has "failed" in par 0155. Tomkow further discloses the notification/delivery receipts of its system contains details information such as the delivery status, see par 0177. The mapping is comparable to the claimed "nature of said impairment" and is reasonably compared and reasonably interpreted.

Therefore, it is clear that appellant's argument is in *clear error*.

Claim 13

Appellant argued that:

(1) Tomkow is silent in "an estimate of when normal mail delivery service can resume."

Examiner respectfully disagrees.

In reply to argument:

Tomkow teaches the formatting a notification comprising a statement of said impairment and forwarding said detailed notification to said identified senders see par 0147-0162 and par 0177. Tomkow did not explicitly disclosing “an estimate of when normal mail delivery can resume.” However, Horvitz discloses a similar teaching of formatting a notification comprising the alleged missing claim limitation: “an estimate of when normal mail delivery service can resume”. Specifically, Horvitz discloses that “the expected time to return determination by the system may be automatically conveyed to senders of highly urgent messages, for example. In this manner, message sender receive feedback when the user is expected to return such that he or she can reply to the messages.” see par 0268. Lines 7-12. This means that Horvitz teaches an estimated (i.e., feedback when the user is expected to return) of when normal mail delivery service can resume (i.e., the user is expected to return such that she/he can reply to the message. The expected return of the user will allow she/he to begins again (resume) reply to the messages thus allowing the system to send the reply message back to the sender (normal mail delivery service). It is the combination of Tomkow in view of Horvitz that discloses the alleged missing limitations.

Therefore, it is clear that appellant’s argument is in *clear error*.

**Rejection of Claims 7-8 and 17-18 Under 35 U.S.C 103 for Obviousness based upon
Tomkow in view of Delaney**
Claim 7

(1) Tomkow in view of Delaney fails to disclose the concept of consulting/probing for information regarding the claimed “respective server”

Examiner respectfully disagrees.

In reply to argument:

(1) Tomkow discloses “consulting a data store of the state information to recall an already identified impairment”. Specifically, Tomkow discloses that “RPost 14 delivery receipts and reading notices are sent to the original sender of the made-of-record message, see par 0147” (i.e., RPost 14 seeks and retrieves to its database for recorded delivered status (consulting state information) such as “delivery failure” or “delivery successful” associated with another MTA (i.e., for selecting ones of said respective mail servers, see Fig 2B-1 and 2B-2) to compose a delivery receipts and reading notice to send to the original sender, see par 0208).

Delaney, similarly teaches that “consulting a data store of the state information for selected ones of said respective mail servers to recall an already identified impairment”. Specifically, Delaney’s transaction server 150 checks (consults) the storage (data store) of recipients schedule (state information) for database 152 (selected one of said respective mail servers) to retrieve (to recall) customers specified (already identified) unavailability to receive (e.g., blackout period) (i.e., impairment associated with the customers), see par 0058 and 0059. Therefore, the combination of Tomkow in view of Delaney teach the limitation of consulting a data store of the state information for selected ones of said respective mail servers to recall an already identified impairment.

Rejection of Claims 3, 10-11, and 20-21 Under 35 U.S.C 103 for Obviousness based upon Tomkow in view of Tomkow2

Claim 3, 10-11, 20-21

(1) The obviousness based upon Tomkow in view of Tomkow2 is not viable based on the argument presented on Claims 1, 5, and 15 since Tomkow2 does not cure the deficiencies of Tomkow.

Examiner respectfully disagrees.

In reply to argument:

(1) Please refer to the responses above in “**Rejection of Claims 1, 4-6, 9, 15-16, and 19 Under 35 U.S.C 102 for Anticipation based upon Tomkow**” session.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

(12) Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Karen Tang

10/22/2008

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